

JAN 08 2007REMARKS

In a Final Office Action mailed on November 8, 2006, claims 22 and 24-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Huber in view of Ackroyd; claim 23 was indicated to be allowable if rewritten in independent form; and claims 1, 3-21 and 31-33 were allowed.

Claim 23 has been rewritten in independent form as newly-added independent claim 34. For at least the reason that the Examiner indicated that claim 23 was allowable if rewritten in independent form, allowance of newly-added claims 34 and 35 is requested.

Regarding the § 103 rejections, the modification of Huber in view of Ackroyd is premised on Ackroyd's statement of the purported desirability of a connector that can sustain a severe impact without becoming disconnected and can provide for ease of disconnection upon withdrawal of the connector from the wellbore. Ackroyd, 1:18-22. The rejections assume that Huber's connector, when modified so that its rotational stop 10a5 is replaced with Ackroyd's tang 40, would have better impact resistance or be easier to disconnect. However, there is no language in Ackroyd that expressly links the tang 40 to either feature; and as set forth below, neither Ackroyd nor Huber supports a finding that a connector that is created by the proposed hypothetical modification would have either feature.

More specifically, there is no language in Ackroyd regarding the tang 40 providing impact resistance or at least more impact resistance than would be provided by a rotational stop. Instead, Ackroyd discloses that the tang 40 allows rotational engagement between the slip 28 and the bottom sub 36 so that these two components may be rotated together. Although rotating the bottom sub 36 and the slip 28 together may arguably facilitate disconnection, it is not clear how the tang 40 provides impact resistance or at least better impact resistance than a rotational stop. It appears that some other feature of Ackroyd's connector may provide the purported improved impact resistance.

Even assuming for purposes of argument that the tang 40 provides for ease of disconnection (the other purported advantage of Ackroyd's connector), this feature is inapplicable to Huber's connector. In this regard, as noted by the Examiner, Huber discloses a rotational stop 10a5 to limit rotation of the sleeve 10b when the sleeve 10b is connected to the first section 10a. However, the first section 10a and the sleeve 10b do not rotate together upon connection or disconnection, a requirement if the element 10a5 is to serve as a rotational stop.

Instead, Huber describes the first section 10a as being mounted to the upper end of a gun string 28, which is presumed to be stationary. *See, for example*, Huber, 9:63-65.

Thus, there is no disclosure in Huber regarding rotating the sleeve 10b and the first section sub 10a together upon the connector's disconnection; and as such, Ackroyd's tang 40 would not further facilitate disconnection of Huber's connector. As set forth above, Ackroyd fails to disclose that the tang 40 provides impact resistance (or at least more impact resistance than would otherwise be provided by a rotational stop. Thus, the cited language from Ackroyd's Background section fails to constitute a proper suggestion or motivation to modify Huber's connector to incorporate Ackroyd's tang 40 to derive the claimed invention. In other words, the Office Action fails to show why substituting Ackroyd's tang 40 for Huber's rotational stop 10a5 produces a modified connector that has either improved impact resistance or is easier to disconnect. As such, Applicant maintains that a *prima facie* case of obviousness has not been set forth for any of claims 22 and 24-26, as the Office Action fails to set forth the requisite suggestion or motivation.

The mere fact that references can be modified is not by itself sufficient to establish a *prima facie* case of obviousness. M.P.E.P. § 2143.01.III. Rather, a *prima facie* case of obviousness requires objective evidence of a suggestion or motivation for the proposed modification, not mere speculation. *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). Because the Office Action fails to set forth objective evidence that supports a finding of the requisite suggestion or motivation for the hypothetical motivation of Huber in view of Ackroyd to derive the claimed invention, Applicant respectfully requests withdrawal of the § 103 rejections of claims 22 and 24-26.

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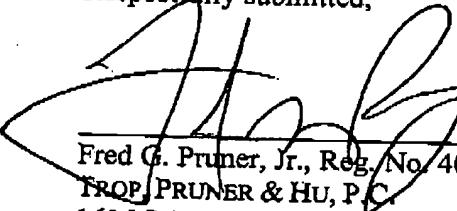
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CONCLUSION

In view of the foregoing, withdrawal of the remaining § 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0281US).

Respectfully submitted,


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